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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,963	09/26/2003	Akira Yamaguchi	Q75437	7028
23373 7590 06/26/2008 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER DHINGRA, PAWANDEEP	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 06/26/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/670,963

Applicant(s)

YAMAGUCHI, AKIRA

Examiner

PAWANDEEP S. DHINGRA

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 9-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9, 11, 12, 14 and 15 is/are rejected.
- 7) ☒ Claim(s) 10, 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

- This action is responsive to the following communication: Amendment after non-final action filed on 2/21/2008.
- Claims 9-15 have been newly added by the applicant.
- Claims 1-5 and 9-15 are pending.

Response to Arguments

Applicant's arguments filed 2/21/2008 have been fully considered but they are not persuasive.

With respect to applicant's arguments, see page 6, that Yamano does not disclose "display means for displaying...evaluation results of the visual evaluation and history thereof". Specifically applicant is arguing that Yamano does not disclose "history of the visual evaluation results being stored in a memory and then displayed".

In response to applicant's argument that "history of the visual evaluation results being stored in a memory and then displayed", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Examiner notes, that Yamano discloses display means 109 (see figure 2) for displaying image data. Display means of Yamano are capable of displaying history of the visual evaluation results.

Applicant further argues on pages 7-8, that Yamano fails to disclose any of the features of claim 1 without providing any substantial reasoning.

In reply, examiner suggests reviewing the discussion of claim 1 below, where Yamano has shown to teach all the features of claim 1 as claimed.

Furthermore, the limitations as argued by the applicant on page 7 (paragraph 2-3) and page 8 (paragraph 1) regarding Yamano not disclosing all or any of those argued limitations of claim 1. Examiner asserts that these limitations are not specified in claim 1 as stated by the applicant on pages 7-8. The specified limitations argued by the applicant shall be incorporated into the claims exactly in order to attain any patentable weight.

Specification

The amendment filed 2/21/2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Claim 9 recites the limitation displaying "sequence of evaluations results of the test patterns". This limitation is not mentioned or supported by the specification.

Claims 12 & 13 recites the limitation "marginal area". This limitation is not mentioned or supported by the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 9 and 12-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 9 recites the limitation displaying "sequence of evaluations results of the test patterns". This limitation is not mentioned or supported by the specification.

Claims 12 & 13 recites the limitation "marginal area". This limitation is not mentioned or supported by the specification.

Claims 1-2 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 9 recites the limitation displaying "sequence of evaluations results of the test patterns". This limitation is not mentioned or supported by the specification.

Claims 12 & 13 recites the limitation "marginal area". This limitation is not mentioned or supported by the specification.

Examiner Notes

Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5, 9, 11-12, and 15 are rejected under 35 U.S.C. 102 (a) or (e) as being anticipated by Yamano, US 2002/0067925.

Re claim 1, Yamano discloses a printer (see figure 1; abstract) having a function to control quality of an output image (see abstract), comprising: output means for

outputting a first test pattern for automatic measurement of image quality (see abstract; paragraphs 205-209, 212, note that the test pattern established by the test pattern setting means is automatically measured by a micro-densitometer and changes are also made automatically, if needed, by the control means 103), and a second test pattern for visual evaluation (see abstract, paragraph 15, note that *"a printing section to print either the medical image or a test-pattern for evaluating a quality of the medical image"*); measuring means (see figures 2-3) for automatically measuring the image quality (i.e. sharpness or granularity) of said first test pattern for the automatic measurement of the image quality (see paragraph 208-209, 212) (also see paragraphs 213-226); determining means (see figure 2) for determining the image quality from image quality data obtained through said automatic measurement by means of said measuring means to obtain determination results (see paragraphs 212-226); inputting means for inputting evaluation results of the visual evaluation of said second test pattern for the visual evaluation (see paragraphs 3-4, 15, 205, 249-261); storage means (see figure 2) for storing said image quality data (see paragraph 17) obtained through said automatic measurement, said determination results and said evaluation results of said visual evaluation (see paragraphs 15-193, 212, 222, 251); and display means (see figure 2) for displaying said stored image quality data, said determination results, said evaluation results of the visual evaluation and history thereof (see paragraphs 15, 87, 212, 268).

Re claim 2, Yamano further discloses first test pattern for the automatic measurement of the image quality pertains to at least one of density, format and sharpness (see paragraph 212-226, 261)

Re claim 3, Yamano further discloses second test pattern for the visual evaluation is at least one of an SMPTE pattern and a standard clinical image (i.e. medical image) (see paragraphs 7-8, 15)

Re claim 4, Yamano further discloses printer (i.e. recording apparatus 40) outputs said first test pattern for the automatic measurement of the image quality and said second test pattern for the visual evaluation on a single sheet (see paragraph 11-15, 212-226).

Re claim 5, Yamano further discloses printer is a medical printer that outputs a transmitting monochrome film (see paragraphs 15, 33, 71, 204, 273, 280).

Re claim 9, Yamano further discloses history (pattern profiles) being displayed is of a sequence of evaluations results of the test patterns (see paragraphs 213-217, 212, note that series of pattern elements are numbered in order to perform evaluation results and the resulting test patterns are then can be recorded and displayed).

Re claim 11, Yamano further discloses wherein said automatic measurement of the image quality pertaining to density, consists of a pattern for measuring three densities: high density, medium density and low density (see figures 4-6; paragraphs 208, 212, 215-248).

Re claim 12, Yamano further discloses wherein said output means further outputs a diagnostic image for a medical use on a recording material in accordance with medical image data (see paragraphs 15, 70-71, 282, 284), and records said first test

pattern for the automatic measurement of the image quality on a marginal area of said recording material (see paragraphs 4-7, 15, 17-18, 204-209,212, note that the test pattern G2 is formed on the marginal area of recording material M as shown in figure 1).

Re claim 15, Yamano further discloses wherein said output means outputs a transmitting medical monochrome film (see paragraphs 15, 33, 70-71, 204, 273, 280-284, note that X-rays can be outputted).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 14 is rejected under 35 U.S.C. 103 as being unpatentable over Yamano, US 2002/0067925 in view of well known art.

Re claim 14, Yamano further discloses determining means determine determination results in a preset allowable range (see paragraphs 244-248).

However, Official Notice is taken to note that ability to output a warning or error or feedback message upon determination of certain unacceptable condition is both notoriously well known and commonly used in the art. For example, a printer when out of paper displays a warning message on the screen. It would have been obvious to display a warning message on the display means of Yamano upon determination of a

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non-suitable density range for test pattern evaluation for the benefit of having the operator or system take appropriate actions in order to obtain suitable evaluations efficiently.

Allowable Subject Matter

Regarding claims 10 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not disclose, teach, or suggest the claimed inventions of (in combination with all other limitations in the claims), sequence being displayed is arranged in terms of times and dates as set forth in claim 10, and marginal area of said recording material on which said first test pattern for the automatic measurement of the image quality is recorded is a part of said recording material concealed by a member of a viewer for observing said diagnostic image on said recording material when said diagnostic image on said recording material is observed on said viewer as set forth in claim 13.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAWANDEEP S. DHINGRA whose telephone number is (571)270-1231. The examiner can normally be reached on M-F, 9:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler L. Haskins can be reached on 571-272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. D./

Examiner, Art Unit 2625

/Twyler L. Haskins/

Supervisory Patent Examiner, Art Unit 2625